REMARKS

This Amendment, submitted in reply to the Office Action dated March 6, 2006, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Claims 1-15 are pending in the present application.

I. Claim Rejections under 35 U.S.C. § 101

Claims 1-5 have been rejected under 35 U.S.C. § 101 because the Examiner asserts that the claimed invention is directed to non-statutory subject matter.

Claim 1 recites "A method for providing prerequisite checking in a system for creating compilations from a plurality of content objects stored in a data repository..." The Examiner asserts that claim 1 is comprised by software alone and does not require any computer hardware to implement the claimed invention. In order to expedite the prosecution for the application, Applicant has amended claims 1-5 to recite a "computer-implemented method." Consequently, the § 101 rejection of claims 1-5 should be withdrawn.

II. Claim Rejections under 35 U.S.C. § 102

Claims 1-15 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Tabuchi (U.S. Patent No. 6,606,633). Applicant respectfully traverses the rejection since Tabuchi does not teach each and every limitation of the claim in as complete detail as recited in the claims.

Claim 1 recites:

> A method for providing prerequisite checking in a system for creating compilations from a plurality of content objects stored in a data repository, each content object comprising a plurality of content entities, some of the content entities being

prerequisites to others of the content entities, comprising the steps of:

upon addition or removal of a content entity to or from the compilation, determining if the content entity has any prerequisite content entities, and if so, adding or removing the prerequisite content entities.

The Examiner now appears to assert that the structure rules disclosed by Tabuchi teach the claimed content entities. See Office Action at page 7, para. C. As previously submitted, the structure rules of Tabuchi do not teach or suggest the claimed content entity. However, even assuming *arguendo* the structure rules teach the claimed content entities, at no point does Tabuchi disclose determining if the content entity (structure rule as cited by the Examiner) has any prerequisite content entities. Further, even if Tabuchi somehow is deemed to teach that the structure rules correspond to the claimed content entities, Tabuchi provides no disclosure of adding or removing any such prerequisite content entities.

Tabuchi merely discloses determining whether a structure rule exists in a structure rule table. When a data object (e.g. text, image, graph) is added to a compound document, the system refers to the structure rule table to determine if a structure rule for that data object currently exists in the table. If a structure rules exists for that kind of data object, then the structure rule will not be added to the structure rule table. If a structure rule for that kind of object does not exist in the table, then the structure rule will be added. See col. 11, lines 1-23. However, Tabuchi provides no teaching or suggestion of determining whether a structure rule (content entity as cited by the Examiner) has a prerequisite structure rule (content entity). Tabuchi also does not teach or suggest adding or removing structure rules that are a prerequisite of that

structure rule. In particular, Tabuchi does not teach or suggest that structure rules (content entities as cited by the Examiner) have prerequisite structure rules.

For at least the above reasons, claim 1 and its dependent claims should be deemed allowable. To the extent claims 6 and 11 recite similar elements, claims 6 and 11 and their dependent claims should be deemed allowable for at least the same reasons.

Claim 3

Claim 3 depends from claim 1, and hence, is patentable for at least the same reasons. Claim 3 also is patentable over Tabuchi because claim 3 recites "wherein the conditions for applying a prerequisite are defined in one or more rules." The Examiner cites the rules described in the Abstract of Tabuchi for teaching the claimed rules. However, the rules described in the Abstract are merely the structure rules which the Examiner cites for teaching the claimed content entities, as recited in claim 1. Applicant submits that it is improper for the Examiner to cite the same aspect of the prior art for teaching distinct claim elements. Moreover, the Examiner's assertion that the structure rules teach the claimed rules evidences that the citation of the structure rules for teaching the claimed content entities is improper. As discussed above, it would be apparent to one of ordinary skill in the art that the structure rules of Tabuchi do not teach the claimed content entity, as further supported by the Examiner's arguments with respect to claim 3.

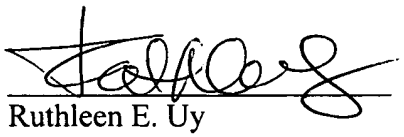
For at least the above reasons, claim 3 should be deemed allowable. To the extent claim 8 recites similar elements, claim 8 should also be deemed allowable for at least the same reasons.

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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